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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of: U.S. Patent No. 5,750,338

Mark L. Collins et al.

Reissue Serial No.: 09/533,906

Reissue Application Filed: March 8, 2000

For: TARGET AND BACKGROUND CAPTURE METHODS WITH AMPLIFICATION FOR AFFINITY ASSAYS

Group Art Unit: 1655

Examiner: D. Johannsen

## **REISSUE LITIGATION BOX**

Assistant Commissioner for Patents

Washington, D.C. 20231

## **EXHIBITS FOR**

## PATENT OWNER'S RESPONSE TO GEN-PROBE'S PROTEST

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	TABLE OF CONTENTS FOR EXHIBITS
1.	U.S. Patent No. 4,683,202, issued July 28, 1987, to Mullis
2.	U.S. Patent No. 5,399,491, issued March 21, 1995, to Kacian et al.
3.	U.S. Patent No. 5,639,599, issued June 17, 1997, to Ryder et al.
4.	U.S. Patent No. 5,731,148, issued March 24, 1998, to Becker et al.
5.	U.S. Patent No. 6,025,133, issued February 15, 2000, to Stull et al.
6.	U.S. Patent No. 6,110,678, issued August 29, 2000, to Weisburg et al.
7.	U.S. Patent No. 6,130,038, issued October 10, 2000, to Becker et al.
8.	Gilles Mangiapan, Martin Vokurka, Leo Schouls, Jacques Cadranel, Denise Lecossier, Jan Van Embden, and Allan J. Hance, Sequence Capture-PCR Improves Detection of Mycobacterial DNA in Clinical Specimens, Journal of Clinical Microbiology, 34:1209-1215 (1996).
9.	Margareta Ieven and Herman Goossens, Relevance of Nucleic Acid Amplification Techniques for Diagnosis of Respiratory Tract Infections in the Clinical Laboratory, Clinical Microbiology Reviews, 10:242-256 (1997).
10.	Axel Ullrich et al., <i>Rat Insulin Genes: Construction of Plasmids Containing the Coding Sequences</i> , Science, 196:1313-1319 (1977).
11.	Russ Higuchi, Gary V. Paddock, Randolph Wall, and Winston Salser, A General Method for Cloning Eukaryotic Structural Gene Sequences, Proceedings of the National Academy of Sciences USA, 73:3146-3150 (1976).
12.	Anthony J. Mazaitis and Ekkehard K.F. Bautz, <i>Partial Isolation of an RIIB Segment of T4</i> DNA by Hybridization with Homologous RNA, Proceedings of the National Academy of Sciences USA, 57:1633-1637 (1967).
13.	W. Stuart Riggsby, A General Method of Fractionation of Nucleic Acids on the Basis of Sequence Homology, Biochemistry, 8:222-230 (1969).
14.	Amos Panet and H. Gobind Khorana, Studies on Polynucleotides: The Linkage of Deoxyribopolynucleotide Templates to Cellulose and Its Use in Their Replication, The Journal of Biological Chemistry, 249:5213-5221 (1974).

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- 15. Kary B. Mullis, *PCR and Scientific Invention: The Trial of DuPont vs. Cetus*, in THE POLYMERASE CHAIN REACTION (Kary B. Mullis et al. eds., Birkhauser Boston, 1994), pp. 428-441.
- 16. Paul Rabinow, MAKING PCR: A STORY OF BIOTECHNOLOGY (Univ. Chicago Press 1996), p. 9.
- S.M. Tilghman, D.C. Tiemeier, F. Polsky, M.H. Edgell, J. G. Seidman, A. Leder, L.W. Enquist, B. Norman, and P. Leder, *Cloning Specific Segments of the Mammalian Genome: Bacteriophage λ Containing Mouse Globin and Surrounding Gene Sequences*, Proceedings of the National Academy of Sciences USA, 74:4406-4410 (1977).
- Stuart H. Orkin, Richard Kolodner, Alan Michelson, and Robert Husson, Cloning and Direct Examination of a Structurally Abnormal Human β<sup>0</sup>-thalassemia Globin Gene, Proceedings of the National Academy of Sciences USA, 77:3558-3562 (June 1980).
- 19. Elizabeth Lacy, Richard M. Lawn, Edward Fritsch, Ross C. Hardison, Richard C. Parker, and Tom Maniatis, *Isolation and Characterization of Mammalian Globin Genes*, in CELLULAR AND MOLECULAR REGULATION OF HEMOGLOBIN SWITCHING, pp. 501-519 (1978).
- 20. A. P. Ryskov, N.E. Maleeva, and S.A. Limborska, Short Communciation: Purification of Large Native DNA Fragments Enriched in Globin Gene Sequences, Gene 3:81-85 (1978).
- 21. Craig Hill, Automating Nucleic Acid Amplification Tests, IVD Technology, 6:36-45 (November/December 2000).
- 22. PCR TECHNOLOGY (Henry A. Erlich, ed., Stockton Press 1989), pp. 1-5.
- 23. PCR PROTOCOLS, A GUIDE TO METHODS AND APPLICATIONS, (Michael A. Innis et al. eds., Academic Press 1990), pp. 13-19.
- 24. E. T. Wang of Painewebber, Inc., *Biotechnology Research Note*, The Investext Group, (OneSource Information Services, Inc. October 26, 2000).
- 25. C. Copithorne et al. of Morgan Stanley, Dean Witter, *Quarterly Income Statements*, The Investext Group, (OneSource Information Services, Inc. October 26, 2000).
- 26. Web pages for Gen-Probe, <u>http://www.gen-probe.com/bottom.html</u>
- 27. David J. Lane, Ph.D., Declaration of David J. Lane, Ph.D. in Support of Motion of VYSIS, Inc. to Compel Gen-Probe, Incorporated to Produce Research and Development and Commercial Success Documents, filed in United States District Court, Southern District of California, November 10, 2000.

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